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10/750,322	01/02/2004	Timothy Joseph Johnson	CRNI.110509	4676

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EXAMINER	
NGUYEN, TRAN N	

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/750,322	JOHNSON, TIMOTHY JOSEPH	
	Examiner	Art Unit	
	Tran Nguyen	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08/13/2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6,7,9-12,15-23 and 26-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,7,9-12,15-23 and 26-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 08/13/2008. Pending claim(s): 1, 4, 6-7, 9-12, 15-23, 26-38. Cancelled claim(s): 2-3, 5, 8, 13-14, 24-25. Amended claim(s): 1, 4, 6-7, 9-12, 15, 18, 20, 23, 34-35, 37-38.

Response to Amendment

As per the rejection of claims 1, 4, 6-7, 9-11, 37-38 under 35 USC 101 imposed in the previous Office Action, this rejection is hereby withdrawn in view of Applicant's amendment to the specification and claims 1, 4, 6-7, 9-11, 37-38.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6-7, 9-12, 15-23, 26-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Fitzgerald (20030191667).

As per claim 1, this claim recites “a computer system... having a plurality of computer software components embodied thereon, the software components comprising: a conditioning engine, the conditioning engine configured for receiving a preliminary billing item…, analyzing… the preliminary billing item by comparison against a compliance template to determine compliance therewith, wherein the compliance template is configured in accordance with the preliminary billing item and comprises data fields that, when satisfied, qualify the preliminary billing item".

Examiner submits that insofar as “a compliance template" is concerned, the claim only recites that the claimed system is capable of comparing data against the compliance template. Examiner submits that the compliance template itself is **not** a structural element of the claimed system.

Examiner interprets " the compliance template is configured in accordance with the preliminary billing item and comprises data fields that, when satisfied, qualify the preliminary billing item” to recite functional limitations of the compliance template; however, since the compliance template is not a structural element of the claimed system, this limitation does not limit the scope of the claim.

To the extent that the compliance template limits the scope of the claim, Examiner interprets this claim to recite that the system is capable of comparing data against a compliance template having the recited functionality.

In particular, “the compliance template is configured in accordance with the preliminary billing item” does not limit this functionality to any particular structure, and

may be reasonably interpreted to be either the claimed system or any unrecited structure.

In applying the broadest and most reasonable interpretation, Examiner does not consider this limitation to limit the scope of the claim.

In the interest of compact prosecution for Applicant, Examiner treats this claim under art as if the compliance template were a claimed structural element; however, Applicant is advised that the applied art need only teach that the disclosed structure is capable of comparing data against a compliance template having the recited functionality, and that neither the compliance template nor the recited functionality are required to part of the disclosed embodiment.

Applicant is suggested to positively recite the compliance template as part of the claimed system, or to cancel this limitation.

Fitzgerald teaches a computer system (Abstract) capable of processing (reads on “conditioning”) patient claim data (reads on “clinically related billing items”) (Abstract), comprising:

(a) software (reads on “a conditioning engine”) (Figure 1-2) capable of:

(i) retrieving a patient claim billing record for a patient encounter with a healthcare provider concerning treatment of an injury (reads on “associated with a clinical event") (Figure 4), wherein the claim data is capable of being submitted for pre-processing by trial adjudicator software (reads on "preliminary billing item") (page 3 paragraph 0025);

(ii) verifying the claim for accuracy (reads on “analyzing”) before (reads on “a condition precedent to") the claim is submitted for payment (reads on “transmitting the billing item to a paying party”) (page 2 paragraph 0021);

(iii) verifying the claim against a plurality of rules (reads on “determine compliance therewith”) (page 2 paragraph 0021), wherein:

(1) the rules comprise a regulatory guideline (page 3 paragraph 0026);

(2) the system is capable of determining a plurality of claim characteristics, e.g. Medicare, Medicaid, etc., to determine the applicable regulatory guideline for compliance therewith (reads on "the compliance template is configured in accordance with the preliminary billing item and comprises data fields that, when satisfied, qualify the preliminary billing item under at least one regulatory guideline”) (page 5 paragraph 0036);

(iv) after the claim is evaluated for accuracy (reads on “upon determining that the billing item complies”), clearing error codes (reads on “dismissing restrictions from elements in the system that prevent the system from configuring the conditioning engine to transmit the preliminary billing item to the paying party”) (page 6 paragraph 0039) and submitting the claim for payment (page 2 paragraph 0021).

As per claim 4, Fitzgerald teaches that the system is capable of transforming data representing rules to a syntax suitable for storage (reads on "a compliance template") (Figure 3 label 317, 321). Fitzgerald further teaches using the stored rules to

verify patient data (page 3 paragraph 0026), procedures (reads on "physicians orders") (Figure 4), and CCI requirements, APGs, DRGs (page 3 paragraph 0026).

As per claim 6, Fitzgerald teaches holding a claim (reads on "holds queue") if the claim data is not in compliance with the rules (reads on "an exception") (page 5 paragraph 0037, Figure 5).

As per claims 7, 9, Fitzgerald teaches amending the claim if necessary (reads on "while in the holds queue") before submitting the claim for payment (page 6 paragraph 0042). Fitzgerald further teaches that upon determination of an exception condition, the system is capable of scheduling manual intervention or providing an alert (page 4 paragraph 0029). Fitzgerald further teaches extracting required claim data from the repository (reads on "automatically retrieving clinical documentation from additional data stores") (page 6 paragraph 0044).

As per claim 10, Fitzgerald teaches a rules warehouse (reads on "a compliance database") (Figure 2 label 74, 78, 16).

As per claim 11, Fitzgerald teaches that the system is capable of adding new rules to the rules warehouse (Figure 3).

As per claim 12, Fitzgerald teaches a method (page 9 claim 25) capable of processing (reads on “conditioning”) patient claim data (reads on “clinically related billing items”) (Abstract), comprising:

(a) retrieving a patient claim billing record for a patient encounter with a healthcare provider concerning treatment of an injury (reads on “associated with a clinical event") (Figure 4);

(b) verifying the claim for accuracy (reads on “analyzing”) before (reads on “a condition precedent to") the claim is submitted for payment (reads on “transmitting the preliminary billing item to a paying party”) (page 2 paragraph 0021) by verifying the claim against a plurality of rules (reads on “determine compliance therewith”) (page 2 paragraph 0021), wherein the rules comprise a regulatory guideline (page 3 paragraph 0026);

(c) performing step (b) above by:

(a) determining the applicable regulatory guidelines, e.g. Medicare Part A, B, Medicaid (reads on “a compliance template” comprising “at least one regulatory guideline”) (page 5 paragraph 0036);

(b) using the collated claim data (reads on “verifying the existence of mandatory documentation”) to verify the claim (page 5 paragraph 0038);

(c) submitting the verified claim (reads on “the complaint billing item and the supporting mandatory documentation used to verify compliance with the compliance template") (page 6 paragraph 0042).

As per the set of claim(s): 15, 16, 17, 18, 19, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 4, 4, 6, 7, 7, respectively, and incorporated herein.

As per claim 20, Fitzgerald teaches amending the claim if necessary before submitting the claim for payment (page 6 paragraph 0042). Fitzgerald further teaches that upon determination of an exception condition, the system is capable of scheduling manual intervention or providing an alert (page 4 paragraph 0029). Fitzgerald further teaches extracting required claim data from the repository (page 6 paragraph 0044).

Examiner considers the regular analysis of the stored claim data to be "automated". Therefore, when the stored claim data is insufficient, manual intervention is requested.

As per the set of claim(s): 21, 22, 23, 26, 27, 28, 29, 30, 31, 32, 33, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 10, 11, 1, 4, 4, 6, 7, 7, 9, 10, 11, respectively, and incorporated herein.

As per claim 34, Fitzgerald teaches healthcare compliance rules mandated by regulators comprising diagnosis codes, CCI requirements, APGs, DRGs (reads on "mandatory documentation and affirming data elements") (page 3 paragraph 0026).

As per the set of claim(s): 35, 36, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 34, 34, respectively, and incorporated herein.

As per claim 37, Fitzgerald teaches associating a rule with an event, wherein the event specifies that new claim data is available for processing (reads on "extracting potential billable items from a clinical data store") (page 5 paragraph 0033).

As per the set of claim(s): 38, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 4, respectively, and incorporated herein.

Response to Arguments

Applicant's arguments filed 08/13/2008 have been fully considered but they are not persuasive.

On page 13-14, Applicant asserts that the specification has been amended to provide a controlling definition for “computer system”.

Examiner submits that the amendment does not introduce new matter into the specification as originally filed because as pointed out by Applicant, Figure 1 of the drawings clearly shows that a hardware definition is required to implement the functionality of the disclosed invention.

Additionally, Examiner recognizes that although numerous definitions for "computer system" may have existed at the time the invention was made, the definition chosen by Applicant for incorporation into the specification does not materially change the scope of the disclosed invention from that previously disclosed because as asserted by Applicant, the amendment simply makes explicit an otherwise inherent or implicit feature of the disclosed invention.

On page 14-15, Applicant refers to various portions of the "ptpub".

Examiner assumes that Applicant is referring to Johnson (20050149365).

Examiner submits that this reference is not in the Official file. Therefore, the cited reference would not be a proper version of the specification as originally filed.

Applicant is requested to refer to the specification as originally filed and available in the Official file.

See MPEP 1730(II)(B)(1)(d) for information on how to access the Official file. See also the last page of this Office Action for information on how to access the PAIR system.

As per claims 1, 23, on page 18 Applicant argues that the applied art do not teach:

(a) "selecting data fields based on the preliminary billing item";

(b) "satisfying the selected data fields in order to find the preliminary billing item in compliance for distribution to a paying party".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., selecting data fields, satisfying data fields) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As discussed above, these features have not been positively recited as part of the claimed system and method.

In the interest of compact prosecution for Applicant, Examiner has treated these limitations under art as if they were positively recited as part of the claimed system and method.

In particular, Fitzgerald teaches selecting rules to apply to the claim (page 5 paragraph 0036).

According to Fitzgerald, claim data is parsed to identify whether the claim is covered under Medicare Part A, B or Medicaid. The system then determines which rules and tests to apply to the claim based on this information (page 5 paragraph 0036).

Examiner interprets determining the applicable regulatory guidelines, e.g. Medicare Part A, B, Medicaid, etc., to be "selecting data fields based on the preliminary billing item".

Examiner also interprets applying the applicable regulatory guidelines to be "satisfying the selected data fields in order to find the preliminary billing item in compliance".

Insofar as “distribution to a paying party" is concerned, Fitzgerald teaches this limitation, as discussed above and incorporated herein.

As per claim 4, on page 19 Applicant argues that the applied art do not teach:

(a) “scanning clinical data stored for evidentiary support that mandatory document exists”;

(b) “utilizing the evidentiary support to verify the existence of mandatory documentation”;

(c) “satisfying the data fields of the compliance template”.

Fitzgerald teaches:

(a) storing collated claim data (reads on "evidentiary support") (page 3 paragraph 0025);

(b) analyzing the collated claim data with derived rules (page 3 paragraph 0026);

(c) determining if the claim meets regulatory guidelines (page 3 paragraph 0026).

In particular, Examiner considers the claim data itself to be a form of “evidentiary support” because regulatory guidelines require claims to be in a specific format. If the claim is not in the required format and do not have the required data consistency, the claim is flagged by the system.

Examiner submits that the stored collated data are embodiments of “affirming data elements” as well because Applicant has not provided any specific definition for these limitations. Therefore, any data capable of being used to verify claim may be reasonably interpreted to be “evidentiary support” and “affirming data elements”.

As per claim 12, on page 20 Applicant argues that the applied art do not teach “a verified billing item" and the components thereof.

Fitzgerald teaches providing the verified claim (page 6 paragraph 0042). Examiner interprets the collated claim data to be the billing item and other mandatory data elements required to verify a claim.

On page 20 Applicant further argues that the applied art do not teach “attaching mandatory document with the claim data when transmitting to a payer".

As discussed above, the claim is transmitted to the payer after the claim is verified, and incorporated herein.

Examiner considers the claim itself to be “mandatory document" already attached as part of the collated claim data.

On page 21 Applicant further argues that the applied art do not teach “data fields” or “mandatory documentation used to satisfy the data fields”.

As discussed above, it is clear from Fitzgerald that the system derives a plurality of rules and stores the rules in computer format (reads on “data fields”) (Figure 3).

Fitzgerald further teaches analyzing the collated claim data, as discussed above and incorporated herein.

Examiner considers the collated claim data itself to be "mandatory documentation”. In particular, it is clear that if a claim is incomplete or otherwise

missing elements, the claim would not pass the regulatory compliance check, e.g. Medicare Part A, B, Medicaid, etc.

“mandatory documentation” need not require additional data other the claim data itself. Applicant appears to argue that this limitation requires data additional to the received claim data.

Examiner submits that the although this interpretation is valid under the claim scope, the claim scope does not limit "mandatory documentation" to data other than the received claim data.

Therefore, receiving claim data, storing the received claim data, and using the stored claim data to analyze the claim is considered to be using "mandatory documentation".

Conclusion

The new ground(s) of rejection presented in this Office action, if any, was/were necessitated by Applicant’s amendment. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3626
11/09/2008